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MM51/1202
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EXAMINER
LEE, M

ART UNIT	PAPER NUMBER
2876	

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/792,468
Filing Date: 01/31/97
Appellant(s): Chizu SHIMIZU et al

Paper No. 27

12/2/98
MP

Patrick D. Muir
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 15 October 1998.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 13-26 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 27 and 30-34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 28 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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Appellant's brief includes a statement that claim 29 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 35 and 36 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,149,947	COLLINS, JR.	9-1992
4,071,740	GOGULSKI	1-1978
3,836,755	EHRAT	9-1974
2,139,889	HEHEMANN	2-1973

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-36 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office action, Paper No. 19.

(11) *Response to Argument*

In response to the Appellants argument that "*Collins, Jr. '947 fails to teach or suggest a commodity code reading section, a prepaid card inputting processing section, a commodity*

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price retrieval section and a data updating section are permanently fixed to a transportable accommodation section ..." (see page 6, lines 13+), *"One of ordinary skill in the art would fail to find any suggestion in Collins, Jr. '947, Gogulski, and Ehrat to permanently fix a prepaid card inputting processing section to a transportable accommodation section ..."*, (see page 7, lines 25+), *"the prior art fails to teach or suggests a payment processor permanently fixed to a transportable container ..."* (see page 9, lines 21+), and *"the prior art fails to teach or suggest the use of any structure permanently attached to a transportable container for paying for selected commodities ..."* (see page 10, lines 6+), the examiner respectfully requests the Appellants to review Collins, Jr. at column 3, lines 46+, and Gogulski at column 5, lines 4+, specifically lines 6-11. Furthermore, in response to the Appellants remarks that *"Gogulski does not suggest modifying Collins, Jr. '947 to permanently fix either a prepaid card inputting processing section or a magnetic card reading section to a transportable accommodation section"*, the examiner respectfully submits to the Appellants that, "It is not necessary that the references actually suggest, expressly or in so many words, changes or possible improvements. All that is required is that the invention was made by applying knowledge clearly present in the prior art." In re Scheckler, 58 CCPA 936, 438 F. 2d 999, 168 USPQ 716 (1971).

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In response to the Appellants argument that “*Gogulski fails to teach or suggest the ability to purchase the item with the system attached to the cart. In particular, a check-out station is still required ...*” (see page 7, lines 1 +), the examiner respectfully request the Appellants to review Collins, Jr., column 4, lines 3 +, “*Also included in the scanning terminal is a slot 88 ... which cooperates with a magnetic stripe reader 90 ... for generating data contained in a credit card (not shown) which is inserted in the slot 88 by the customer for use in paying for the purchased merchandise items*”, and Gogulski, columns 1 and 2, lines 7-9 and lines 54 +, respectively, “*self-service shopping whereby customers, when purchasing items, need not check individual items through a check-out counter*” and “*... he scans the line-encoded data imprinted on the item with the first hand-held scanner and the price of that item appears on the display unit along with the item’s unit price and identification. If the shopper wishes to purchase the item and if he feels that the data appearing on the display unit is correct, he scans the item over the second stationary scanner which redisplay the same information and enters the price total on the customer’s receipt ...*”.

As to the “*consumer performs the steps of selecting a first commodity to be purchased at a first selection site, reading the commodity code of the first commodity at the first selection site using a commodity code reader attached to a transportable container, and paying for the*

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first commodity at the first selection site using a payment processor attached to the transportable container” (see page 8, lines 15+), and “selecting a second commodity to be purchased at a second selection site, different from the first selection site, and reading a second commodity at the second selection site, and paying for the second commodity using the payment processor attached to the transportable container” (see page 9, lines 8+), the examiner contended that such procedures are conventional procedures for one of ordinary skill in the art to have contemplated in that the vendee may choose to either pay for a single item/commodity at a time or to pay for a plurality of items/commodities in a batch mode, and accordingly, to incorporate such conventional scheme and/or procedure would have constituted an obvious expedient, well within the ordinary skill in the art, as taught by Collins, Jr. as modified by Gogulski. Moreover, the Appellants did not contend that such procedures as discussed above are conventional procedures as indicated/discussed by the examiner in the final office action (see paper no. 19, page 5, lines 12+).

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MGL
November 30, 1998

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*Group 2800
11/30/98*

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